

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AYLO FREESITES LTD,
Petitioner,

v.

WELLCOMEMAT, LLC,
Patent Owner.

Case IPR2024-00710¹
U.S. Patent No. 8,307,286

PATENT OWNER SUR-REPLY

¹ The Board consolidated later-filed IPR2024-01101 (Claim 17 of the '286 Patent) with IPR2024-00710 (Claims 13-15, 18-20).

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Ex. 2002	WellcomeMat website at https://go.wellcomemat.com/integrate-videos (accessed 4-18-2024)
Ex. 2003	Unified Patents summary of IPR2024-01101 at https://portal.unifiedpatents.com/ptab/case/IPR2024-01101 (accessed November 4, 2024).
Ex. 2004	U.S. Pat. App. Pub. No. 2007/0263984 (Sterner '395 App)
Ex. 2005	U.S. Pat. No. 8,170,395 (Sterner '395 Patent)
Ex. 2006	FWD, IPR2020-01697, Paper 38, 4-15-2022
Ex. 2007	National Judicial Caseload Profile Statistics June 2024
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Ex. 2009	U.S. Pat. Pub. 2005/0152665A1 (Shibata)
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Ex. 2012	What is MYSQL? (accessed at oracle.com on 6-23-2024)
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Ex. 2014	C.V. of Dr. Mark Mahon, Ph.D.
Ex. 2015	Declaration of Dr. Mark Mahon, Ph.D.
Ex. 2016	WO2005071962A1 to Wasilewski (Scientific-Atlanta)
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Ex. 2018	Docket Report WellcomeMat v. Aylo (EDTD)
Ex. 2019	U.S. Pat. No. 10,631,026 to Carlucci (Time Warner Cable)
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I. INTRODUCTION

As explained below, the Petitioner’s Reply fails to rehabilitate the defective arguments of the Petition.

II. PETITIONER’S EXPERT

Petitioner does not dispute that Dr. Houh submits a super-human 60 IPR declarations each year under his name—more than 1 per week—and that each of those declarations is between 120 and 150 pages. In this IPR, Dr. Houh submitted a massive 275-page opening declaration. POR, 6-8.

Petitioner *does not dispute* that *any expert* working at this nearly impossible pace—more than 1 expert declaration per week—would be expected to produce declarations having reliability issues. See Reply, 9-10.² And Petitioner does not refute the material errors that Patent Owner identified in Dr. Houh’s original declaration, such as his erroneous assertion that a Home Area Network is a public network.

² Acting Director Coke Stewart has highlighted the problems with petitioners relying on unduly extensive expert evidence. See “Interim Processes for PTAB Workload Management,” March 26, 2025, 2 (petitioner’s excessive reliance on expert testimony).

Given these undisputed points, the Board should assign little weight to Petitioner's expert's declaration.

III. CLAIM CONSTRUCTION

Limitation 13.1 recites *providing a computer system ... comprising a video editing environment, and being disposed on a server side of a public network*.

Patent Owner explained that, based on the intrinsic evidence, a POSITA would understand the limitation to require *a server-side video editing environment* application for editing cue points that enables remote cue point editing by a client over a public network, as opposed to local cue point editing using a local client application. POR, 9-14.

On reply, Petitioner submits a different construction for limitation 13.1 that is not based on the intrinsic evidence. Reply, 1-3. To support that construction, Petitioner ignores the prosecution history statements that inform the meaning of the claim language, asserting that there is no prosecution disclaimer. Reply, 2-3. But Patent Owner is not relying on disclaimer. Rather, the consistent characterization of the claim language during prosecution informs the meaning of the claim language. The Reply does not address any of referenced cases or the multiple statements from the prosecution history supporting the Patent Owner's construction. POR, 13-14. Reply, 1-3.

IV. PETITIONER'S COMPARISONS OF THE REFERENCES TO THE SPECIFICATION OF THE '286 PATENT ARE IMPROPER AND IRRELEVANT

Petitioner spends dozens of pages comparing the prior art to various embodiments disclosed in the '286 Patent. See, e.g., Reply, 3-9 (see Section I.B-C), 13-16 (Section II.A.3), 24-28 (Section III.A.3).

It is black letter law that the validity inquiry is based on comparing the prior art to the *limitations of the claims*, not by comparing the prior art to *embodiments disclosed in the specification*. *TQ Delta, LLC v. DISH Network LLC*, 929 F.3d 1350, 1357 (Fed. Cir. 2019); see *Graham v. John Deere Co.*, 383 U.S. 1, 13 (1966). The Board should not be swayed by the Petitioner's transparent attempt to distract the Board from the claim language at issue. See Reply, Section I.B-C.

Not only are these comparisons legally improper, but the factual assertions are incorrect and off-point.

For example, the Reply's reference to the disclosure of an embodiment in the '286 Patent specification for the client to use a browser-based form to transmit cue point information is not relevant. Reply, 3-7. Independent Claim 13 recites server-side operations, not client-side operations for inputting cue point information using a form. Even the Petitioner admits that its argument about the disclosure of client-side forms is not relevant. Reply 15 ("The Challenged Claims do not mention user interfaces").

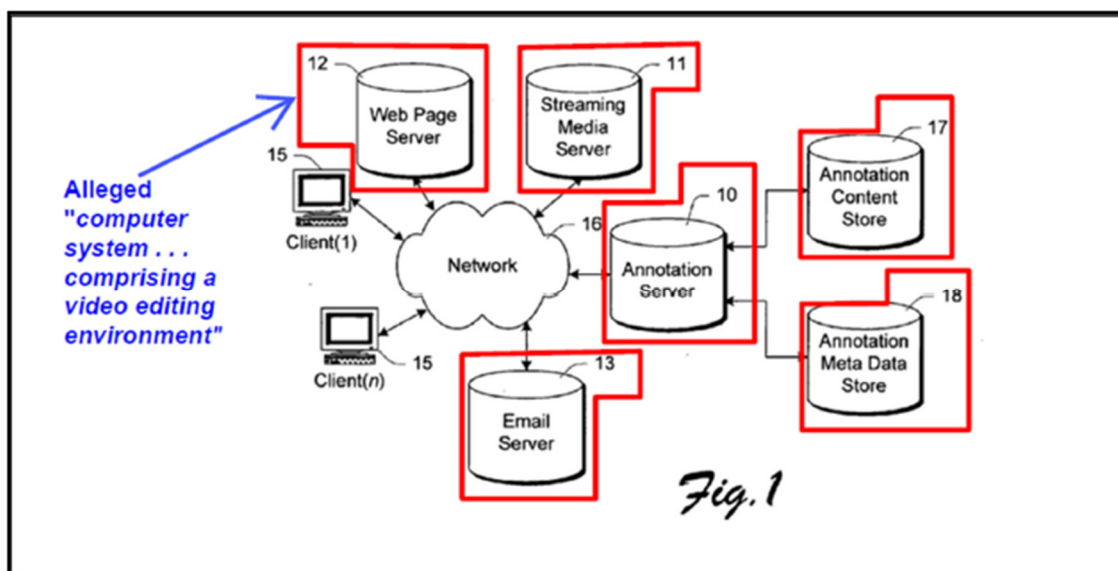
Petitioner describes the exemplary client-side GUI of Figure 6 from the specification of the '286 Patent. Reply, 5-7. This is not relevant because Petitioner does not link Figure 6 to the limitations of Claim 13, which focus on server-side operations. Petitioner is improperly trying to rewrite the server-side limitations of Claim 13 to insert client-side limitations.

Similarly, the Petitioner's argument that the specification discloses that server-side scripts such as CGI can be used (Reply, Section I.C, at 8-9) is also untethered to the language of Claim 13.

V. INDEPENDENT CLAIM 13 AND DEPENDENT CLAIMS 15 AND 18 ARE NOT ANTICIPATED BY GUPTA (GROUND 1)

A. Gupta Does Not Disclose Limitations 13.1-13.5

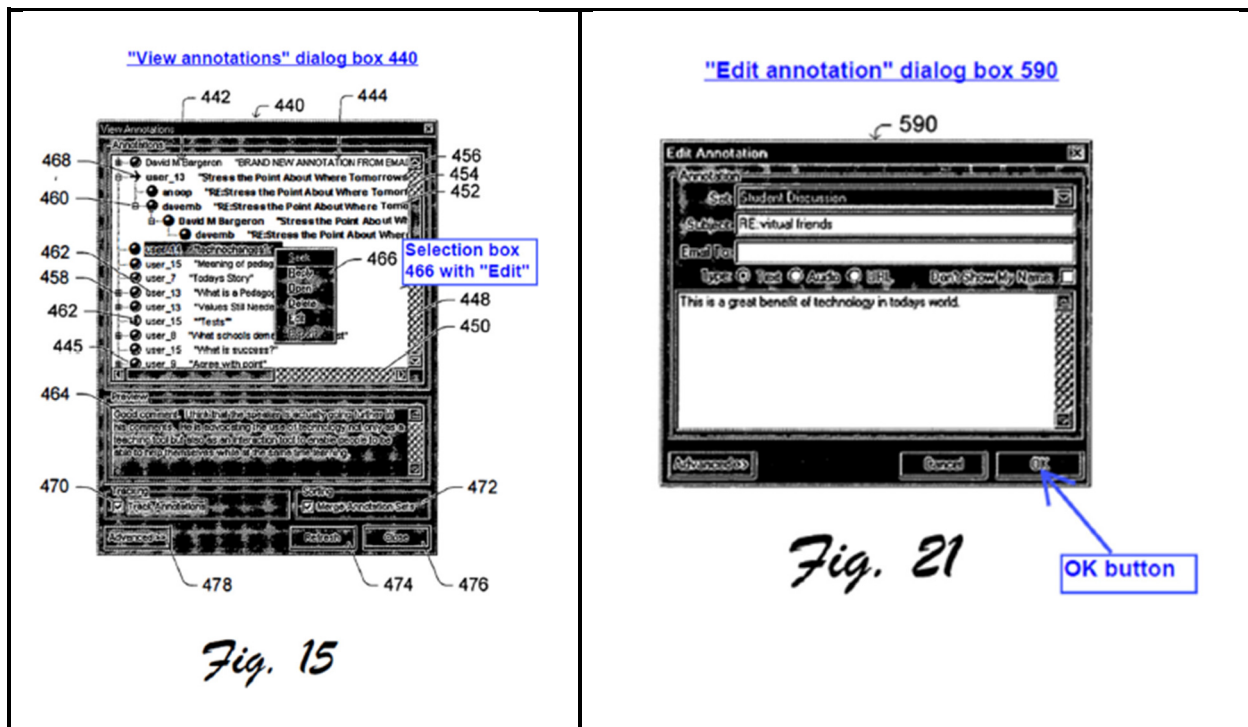
Petitioner argues that the *server-side video editing environment* of limitation 13.1 is disclosed by the red-boxed components of Gupta:



POR, 15 (citing Pet., 15).

But Gupta *repeatedly* discloses that its video editing operations—including the View Annotation dialog box of Figure 15 and the Edit Annotation dialog box of Figure 21 that Petitioner relies on for limitations 13.1-13.5—are performed by the *client-side* user interface module (UIM) 152 application executing on client 15. See POR, 15-23. Gupta, [0082] (“The interface module 152 is an application program ... that is executed at client 15”); [0081] (UIM 152 creates the client-side dialog boxes including the annotation toolbar of Fig. 6), [0087] (selection of “show annotations button 266” from Figure 6 “causes interface module 152 to open a ‘view annotations’ dialog box” of Figure 15), [0128] (“Selection of the ‘edit’ feature [in Fig. 15] causes interface module 152 to display another dialog box [Fig. 21] allowing the user the edit the content of the annotation”). See Mahon Decl., ¶¶ 109-117.

Thus, the View Annotation dialog box and the Edit Annotation dialog box that Petitioner relies upon (see Pet., 22-24) for limitation 13.4 (*cue point editing command transmitted over the network*) are client-side dialog boxes created by the client-side UIM application for the client-side editing of annotations, as depicted below:



See POR, 21-23. See e.g., Pet., 27-30 (limitation 13.4 allegedly met by Figs. 15 and 21 of Gupta).

The Reply (at 10) does not dispute that the editing of annotations in Gupta is performed by the client-side dialog box of Figure 21 that is generated by the client-side UIM application. Accordingly, Gupta does not disclose limitation 13.1.

Indeed, acknowledging the weakness in its original argument, Petitioner presents a new argument on reply that Gupta's MAWS module 130 somehow discloses limitation 13.1. Reply, 12. The Petition did not mention MAWS at all. The Board should reject this argument because the Petitioner is limited to the arguments made in its original petition and cannot present new theories on reply. See *SAS Institute Inc. v. Iancu*, 138 S.Ct. 1348, 1355 (2008); *Qualcomm, Inc. v.*

Apple, Inc., 20 WL 1174161 (Fed. Cir. 2025) at *10; Consolidated Trial Practice Guide (Nov. 2019), 73-74 (“Petitioner may not submit new evidence or argument in reply that it could have presented earlier”).

Further, Petitioner’s new argument fails on the merits. Gupta states that MAWS is an “Internet Services Application Programming Interface (ISAPI) plug-in for Internet Information Server (IIS) module 135” and “together these two modules provide the web server functionality of annotation server 10.” Gupta, [0047]. This is no more than a generic statement that Gupta’s annotation server 10 can use Microsoft IIS for its web frontend. It does not remotely disclose the claimed server-side *VEE* providing for editing annotations/cue points to enable remote cue point editing by a client per limitations 13.1-13.5.

Nowhere does Gupta disclose that MAWS creates the dialog boxes of Figures 7, 8, and 21, as suggested. Reply, 13. As explained in detail in the POR and Patent Owner’s expert declaration, Gupta repeatedly discloses that the *client-side* UIM application generates those interfaces for locally creating and editing annotations. POR, 20-24. See Mahon Decl., ¶¶109-117.

Petitioner next points out that the client-side UIM application can be originally provided by a remote server and then stored (e.g., downloaded) at client 15. Reply, 15 (citing Gupta, [0082]). That does not alter the analysis because how client 15 acquires the UIM 152 application is not germane. What is material is that,

when used, UIM 152 is a client-side application executed by client 15 that generates the dialog box of Figure 21 providing for client-side editing of annotations. Patent Owner's expert's detailed reasoning supported by evidence should be credited over Petitioner's expert's conclusory reasoning. See Mahon Decl., ¶¶ 109-117.

Petitioner also recites Gupta's disclosure that "[a]nnotation content **authored at client 15, using user interface 152**, is received by ABE 132 and **maintained in annotation content store 17**" as support for the assertion that "the client sends a cue point editing command to annotation server 10 with annotation information for storage." Reply, 16 (citing Gupta, [0048] (emph. added)). The cited passage does not *remotely* support the conclusion. As Gupta states, the annotation content is "***authored*** at client 15" using the ***client-side*** UIM application and then, as Petitioner admits (Reply at 13), is simply uploaded "for storage." That does not meet Claim 13, which requires that a *cue point editing command* be sent over the network to cause *server-side* modifying of cue point information.

Notably, the Reply drops the Petition's argument that the use of HTTP in Gupta somehow discloses limitations 13.1 and 13.4-13.5. See POR, 27-28.³

B. Petitioner's Improper Comparison of Gupta to Embodiments Disclosed in the Specification Is Unavailing

As discussed above in Section IV, Petitioner's attempt to prove its anticipation theory by comparing Gupta to the specification of the '286 Patent is improper and should be disregarded. Reply, 13-16.

This irrelevant analysis does not even reference the claim language from independent Claim 13. See Reply, 13-16. It also fails to account for the fact that the specification of the '286 Patent includes an unclaimed embodiment. See POR, 12.

C. Gupta Does Not Anticipate Claim 15

For Claim 15, Petitioner observes on reply that selecting "Edit" in Figure 15 of Gupta causes the Edit Annotation dialog box of Figure 21 to be displayed. That is correct. But Gupta does not disclose that selecting Edit causes an *edit mode entry*

³ WellcomeMat has not asserted that HTTP cannot be used in connection with the claimed invention, as suggested. See Reply, 13. As previously explained, HTTP is a standard protocol that can be used for client-server communications. POR, 27.

signal to be sent *over the network* as Claim 15 requires. On the contrary, Gupta expressly states that the Edit Annotation dialog box of Figure 21 is generated ***locally*** by the client-side UIM application without any signal being sent over the network: “Selection of the ‘edit’ feature causes ***[user] interface module 152*** to display another dialog box [Fig. 21] allowing the user to edit the content of the annotation.” Gupta, [0128]. Gupta itself thus shows that Petitioner’s assertion that Figure 21 “cannot be generated locally” is wrong. See Reply, 18.

Further, Petitioner’s improper new argument about “current information” being displayed (Reply, 17-18)⁴ does not change the outcome. Gupta discloses that the Edit Annotation dialog box is locally-generated by the client-side UIM application, and the editing of annotations occurs entirely on the client-side. This is true whether the current annotation information was already stored at the client or is retrieved from the server-side.

D. Gupta Does Not Anticipate Claim 18

For two reasons, Petitioner’s assertion that Gupta’s annotation server 10 “supports” read and write access controls (Reply, 18) does not establish that they

⁴ Petitioner makes no link between “current information” and the *edit mode entry signal* at issue.

are transmitted *over the network as authentication information* as Claim 18 requires. POR, 34-35. First, Petitioner's argument should be disregarded as a new inherency argument first presented on reply. See Pet., 31. Second, even if considered, the argument is wrong. A POSITA would readily appreciate that read/write access controls and related information in Gupta could be entered directly into annotation server 10, as opposed to being transmitted over the public network. Thus, it is not inherent that Gupta discloses transmitting such information over the network as required by Claim 18. *Par Pharm. v. TWI Pharm., Inc.*, 773 F.3d 1186, 1194-1996 (Fed. Cir. 2014) (inherency cannot supply a missing limitation in an obviousness analysis if the limitation at issue is not necessarily present in the prior art).

VI. INDEPENDENT CLAIM 13 AND DEPENDENT CLAIMS 15 AND 18 ARE NOT ANTICIPATED BY FEGAN (GROUND 2)

A. Fegan Does Not Disclose Limitations 13.1-13.5

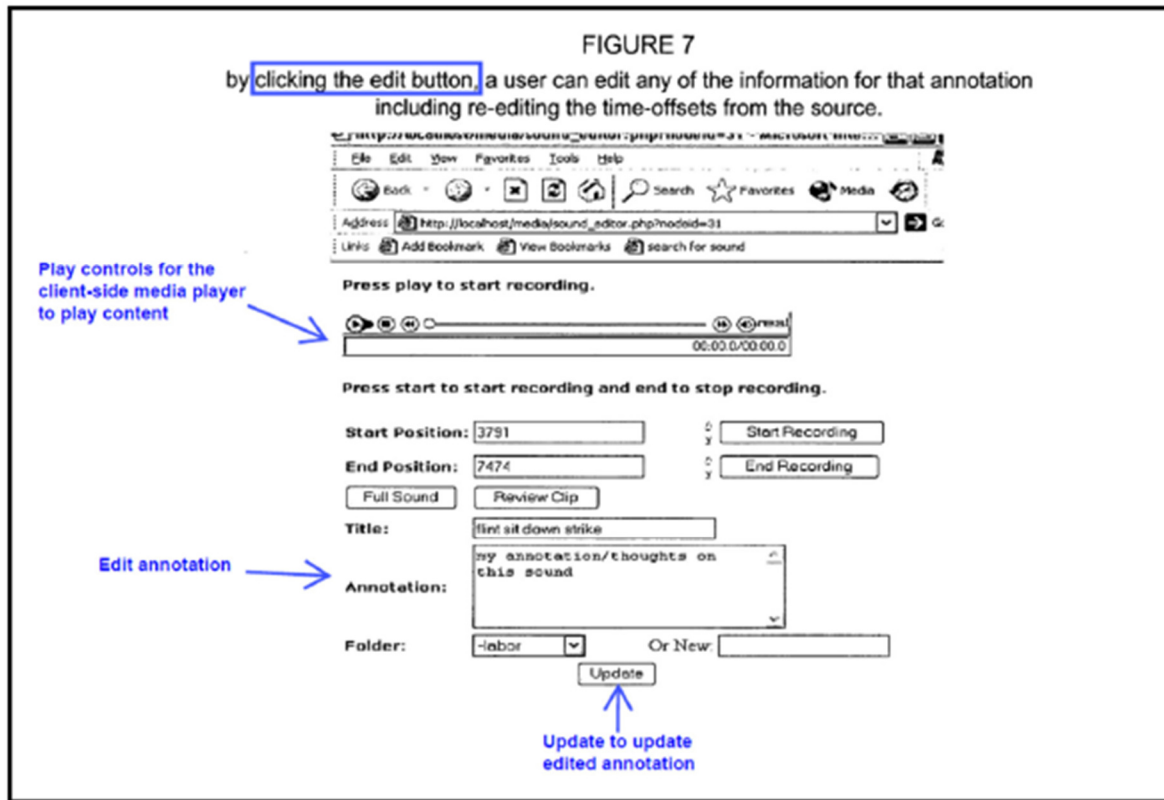
In the Institution Decision, the Board questioned whether Fegan discloses limitations 13.1 and 13.4-13.5 of Claim 13 and asked the parties to address “whether the segmenting and annotation tools of the browser-based media player are executed on the client side or server side of the network.” Instn. Dec., 33. The evidence shows that such tools are executed solely on the client-side, such that Fegan does not disclose any of limitations 13.1 or 13.4-13.5.

Limitation 13.1

Significantly, Petitioner answers the Board’s question by conceding Patent Owner’s argument that Fegan “performs editing locally through client side software” such that “segments and associated annotations are created using client side applications.” Reply, 21 (quoting POR, 36, 38). That is dispositive as Claim 13 requires that such operations be performed by the computer system on the server-side of a public network in response to a *cue point editing command* sent by a remote client terminal over the public network, which Petitioner admits is not occurring in Fegan.

Patent Owner’s answer is no different: Fegan discloses only the editing of annotations using client-side software, not server-side software responding to a *cue point editing command* sent over a public network as required by Claim 13.

For example, Figure 7 provides client-side editing using client-side software. In fact, it references the URL http://localhost/media/sound_editor.php?nodeid=31, which demonstrates that the browser is interacting with a local computer to perform any video editing locally:



POR, 39 (Fegan, Fig. 7). The “localhost” URL confirms that the browser is being used to communicate with a local computer system and thus does not involve a remote client terminal sending a *cue point editing command* over a public network to a server-side system as Claim 13 requires.⁵ POR, 38-39, 42-43. See Fegan, Fig. 7 (URL address is “<http://localhost...>”). Mahon Decl. ¶¶ 213-214, 218-222.

⁵ As Patent Owner stated previously (see POR, 38 n.1), it does not dispute that Claim 13 encompasses use of a browser to access a server-side VEE that performs editing of cue points. The key distinction in this case is that the browser

Limitation 13.4

The Petition argued that selecting “Update” in Figure 7 of Fegan causes the client to transmit a *cue point editing command* per limitation 13.4. Pet., 45. Patent Owner explained that Fegan provides no disclosure that selecting Update causes the client to perform ***any particular operation***, let alone cause the client to transmit a *cue point editing command* over the network as claimed. POR, 41-43. The Reply does not resolve this fundamental defect with Petitioner’s argument.

For example, the Reply argues that the Update button causes annotation information to be transmitted for storage in a user-selected “Folder” that Petitioner alleges is at a remote server. Reply, 23-24. But Fegan’s entire disclosure regarding Figure 7 is the following:

FIG. 7 shows a saved annotation that has been opened via the directory for further editing. In preferred embodiments, annotations may be freely created, edited, and deleted without limitation.

in Fegan is not being used to perform such editing by transmitting a *cue point editing command* over a public network. Rather, it is communicating locally and thus does not disclose the remote cue point editing over a public network as claimed.

Fegan, [0081]. There is ***no discussion*** of the Update button, much less anything to support Petitioner's view of it.

Additionally, contrary to Petitioner's assertion, Figure 5 shows that the user-selected folder that the Petitioner references is located at the URL <http://localhost/media/>. Fegan, Fig. 5 (user's personal portal page is at "localhost"). The reference to "localhost" thus shows that the user-selected Folder in Figure 7 is local storage, not a remote server, as Petitioner contends.

As shown earlier, Figure 7 likewise has a "localhost" URL, which shows that the browser is communicating with a "localhost" and thus is not sending a *cue point editing command over the public network*. POR, 39, 41-43. Further, the ground asserted is **anticipation**, and the Petitioner cannot fill gaps in the Fegan reference by the alleged "understanding of a POSITA."

Petitioner also improperly points in its reply to the "Add" button of Figure 4 as a new theory for limitation 13.4. See Pet., 45 (only relying on Update button of Fig. 7 for limitation 13.4), Reply, 23 (newly relying on Add button of Fig. 4 for limitation 13.4). This new theory should be disregarded because it was not presented in the Petition. See *SAS*, 138 S.Ct. at 1355; *Qualcomm*, 20 WL 1174161 (Fed. Cir. 2025) at *10; CTG (Nov. 2019), 73-74. It also fails on the merits because Fegan does not disclose that selecting Add in the Annotation Creation window of Figure 4 causes any particular operation to occur, let alone operations

corresponding to limitations 13.1-13.5, including sending a *cue point editing command* over the network. Indeed, there is ***no discussion*** in Fegan of the Add button of Figure 4 at all. See Fegan, [0074]-[0080] (addressing Fig. 4 without any discussion of Add button).

For any of these reasons, there is no support for the assertion that Fegan's Add/Update buttons disclose transmitting a *cue point editing command* over the public network as limitation 13.4 requires. See POR, 41-43. Mahon Decl., ¶¶ 216-222.

In summary, Fegan does not disclose that selecting Update in Figure 7 (or Add in Figure 4) causes the transmission of a *cue point editing command* per limitation 13.4.

Other Arguments in the Reply

Petitioner continues to improperly conflate the claimed “*editing*”/“*modifying*” of annotations with the mere “storage and retrieval” of locally-created annotations in a database, as described in Fegan. See Reply, 19. But merely uploading or downloading locally edited content is not enough. Claim 13 requires editing/modifying annotations on the server-side in response to a *cue point editing command* sent by the client over the public network.

Petitioner also suggests that the use of generic “Internet-based website technology” somehow discloses limitations 13.1-13.5. Reply, 20. But Fegan's

general reference to the use of Internet website technology such as PHP does not disclose limitations 13.1-13.5 of Claim 13. See Reply, 20 (citing Fegan’s generic statement at [0010] that in some embodiments “the features of the present invention are encoded in PHP.”). Notably, the Petition mentions PHP *only once* (Pet., 34) and does not argue PHP in relation to limitation 13.4.

Likewise, Fegan’s general statement that “technical tools for carrying out the multimedia presentation are maintained on the server side” (Reply, 21) is directed to “carrying out” a “multimedia presentation,” not to editing and modifying annotations as called for by limitations 13.1-13.5. The Reply does not even try to link the cited disclosure to the claim limitations.

Petitioner also cites various passages in Fegan that reference searching for multimedia content on the Internet. Petitioner also cites passages referencing the local storage of locally created segments/annotations, such as at a “user’s portal page” that is on the “localhost.” Reply, 22-23 (citing Fegan, [0005], [0069], [0073], [0075], [0080], [0081], Fig. 5.). See Fegan, Fig. 5 (annotation stored on user portal at URL at “localhost.”). In essence, these passages disclose that the multimedia materials can be stored on remote servers and then retrieved and edited locally, with the results stored locally. That does not disclose limitations 13.1-13.5 of Claim 13, which require that the editing be performed on the server-side by sending a *cue point editing command* over the public network.

B. Petitioner’s Improper Comparison of Fegan to Embodiments Disclosed in the Specification Is Not Relevant

As discussed above in Section IV, Petitioner’s attempt to prove anticipation by comparing Fegan to the specification of the ’286 Patent is improper and should be disregarded.

The analysis in Petitioner’s Section III.A.3 does not even reference the claim language, let alone explain how Fegan discloses limitations 13.1-13.5.

C. Fegan Does Not Anticipate Claim 15

In its POR, Patent Owner explained that there is no disclosure in Fegan that selecting the “Edit” button in Figures 5 or 6 causes the transmission of a signal *over the network* to the server-side, let alone a signal corresponding to the claimed *edit mode entry signal* of Claim 15. POR, 43-44. Even if, *arguendo*, there was a signal, Figures 5-7 demonstrate that it would be sent entirely locally, i.e., to the “localhost,” not over the public network as required by Claim 15. See Fegan, Figs. 5-7 (URL to “localhost”).

The Reply cites Fegan’s reference to client browsers sending requests to web servers. Reply, 29 (citing Fegan, [0037]). But Fegan’s reference to generic request/response interactions between clients and servers does not remotely disclose the *edit mode entry signal* of Claim 15.

Petitioner also references alleged server-side PHP scripts in connection with Figures 5 and 7. Reply, 31-34. First, this is an improper new theory because the Petition never made a PHP argument for Claim 15. See Pet., 50. Second, the argument fails on the merits. As explained above in the context of Claim 13, there is no disclosure in Fegan that selecting Edit in Figure 5 causes the client to transmit a signal *over the network* to a server, let alone an *edit mode entry signal* as claimed. See Fegan, [0081] (addressing Figs. 5-7 with no discussion of client issuing a signal if Edit is selected). Rather, as explained, Figures 5 and 7 demonstrate that any signal would be sent entirely locally, i.e., to the “localhost.” Petitioner continues to forget that its theory is anticipation, not obviousness.

Thus, Fegan does not disclose the *edit mode entry signal* transmitted over the public network to cause cue point editing on the server-side according to Claim 15 in conjunction with Claim 13.

D. Fegan Does Not Anticipate Claim 18

Patent Owner explained that the disclosure in Fegan of a “personal portal” for locally storing user information does not anticipate Claim 18. POR, 44-45.

On reply, Petitioner essentially concedes Claim 18, arguing that “a POSITA *would have understood* Fegan’s reference to a personal portal page” to “involve” sending authentication information to a server. Reply, 34. The ground here is

anticipation, not obviousness. Petitioner cannot fill gaps in Fegan with a hypothesized “understanding of a POSITA.”

VII. INDEPENDENT CLAIM 13 AND DEPENDENT CLAIMS 15 AND 18 ARE PATENTABLE OVER KIM (GROUND 3)

On reply, the Petitioner does not dispute any of Patent Owner’s arguments and evidence demonstrating that multiple limitations of Claims 13, 15, and 18 are not satisfied by Kim. Reply, 35.

Accordingly, Petitioner has conceded that the Challenged Claims are patentable over Kim.

VIII. INDEPENDENT CLAIM 13 AND DEPENDENT CLAIMS 15 AND 18 ARE PATENTABLE OVER BY KIM AND GUPTA (GROUND 4)

On reply, the Petitioner does not dispute any of Patent Owner’s arguments and evidence demonstrating that multiple limitations of Claims 13, 15, and 18 are not met by Kim in view of Gupta. Reply, 35.

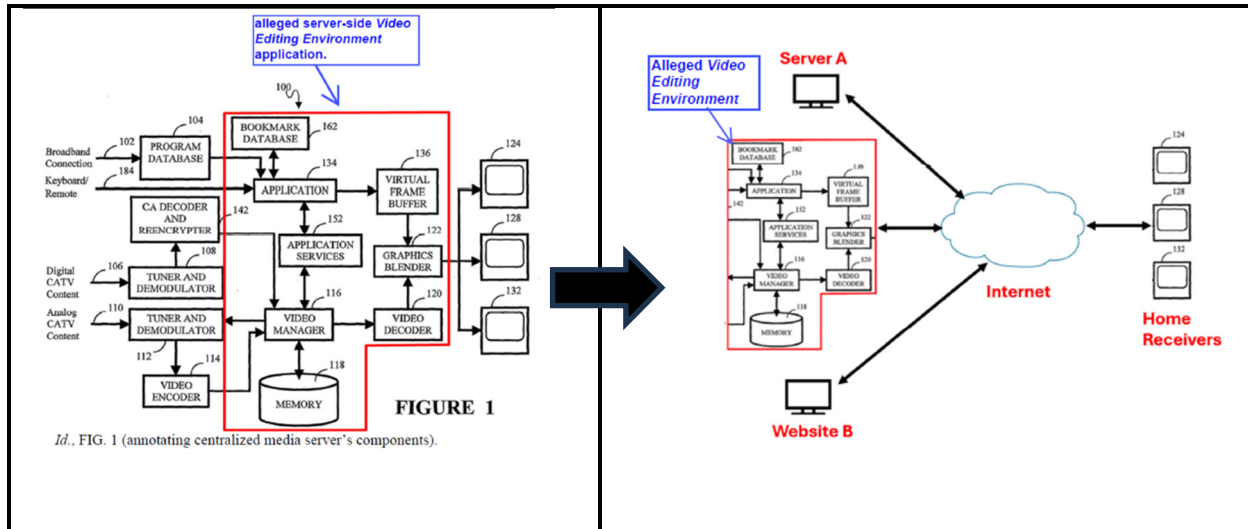
Accordingly, Petitioner has conceded that the Challenged Claims are patentable over Kim and Gupta.

IX. INDEPENDENT CLAIM 13 AND DEPENDENT CLAIMS 15 AND 18 ARE PATENTABLE OVER VASILEVSKY/LOGAN (GROUND 5)

A. Vasilevsky/Logan Fails to Meet Limitations 13.1-13.5

Many of the fundamental problems with this obviousness theory are illustrated by Petitioner’s proposed modification, which is to take a portion of

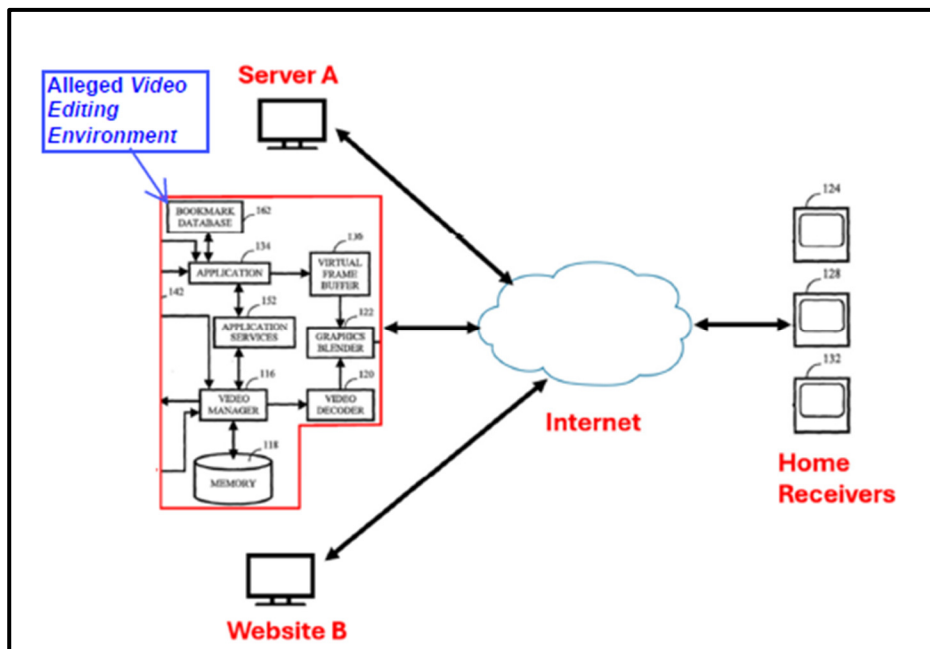
Vasilevsky (see alleged *video editing environment* in the red box) [left hand side]
and modify it by rehosting it onto the Internet [right hand side]:



Pet., 75 (left hand side); POR, 66-67 (citing Mahon Decl., ¶ 340) (right hand side—proposed modification by rehosting alleged *VEE* onto the Internet, citing Ex. 2022).⁶

For ease of reference, the proposed modified Vasilevsky system is depicted below:

⁶ On reply, Petitioner does not dispute the Patent Owner's and its expert's depiction of Petitioner's proposed modification of Vasilevsky. See POR, 63-67 (see POR, 67, citing Mahon Decl., ¶ 340, Ex. 2022). See Reply, 35-39.



POR, 66-67 (citing Mahon Decl., ¶ 340, Ex. 2022).

Patent Owner explained that the proposed modification of rehosting the alleged *video editing environment* of Vasilevsky onto the Internet creates numerous problems, such as: (1) the modified system would not work; (2) a POSITA would not have reason to make the modification; and (3) there would not be a reasonable expectation of success that the modified system would work for its intended purpose.

For example, the rehosted *VEE* on the Internet would be missing the following critical components of Vasilevsky's system: digital and analog television tuner/demodulators 108/112, conditional access decoder and re-encryptor 142, and video encoder 114. Vasilevsky, 13:5-15:4, Fig. 1. POR, 63. Petitioner does not deny this on reply. The modified Vasilevsky system would not work because it is

missing critical front-end circuitry needed by the alleged *VEE* to receive, decode, decrypt, re-encrypt, and encode television programming before it is stored in memory 118. POR, 66-67 (citing Mahon Decl., ¶¶ 327-332, 340-344).

There are other reasons why the proposed modified system would not work. For one, the modified Vasilevsky system has no cable lines to receive digital and analog CATV content 106/110. *Compare* Vasilevsky, Fig. 1, *with*, modified Vasilevsky system (Ex. 2022). POR, 64. Thus, the modified Vasilevsky system could not receive television content via cable lines. On reply, Petitioner newly asserts that “Vasilevsky is a cable TV system and [] cable line connections would need to be maintained.” Reply, 36. But the Petition never made that assertion, and its proposed modification did not include this further modification to somehow connect cable lines to the alleged *VEE* rehosted onto the Internet.

Petitioner also argues on reply (at 36) that it was known for cable television content to be delivered over the Internet, but it did not propose that further modification in its Petition. As such, this is an improper new theory of obviousness. Even so, a POSITA would understand that the proposed modified Vasilevsky system would have to be *further* modified so that the end user devices 124-132 could receive, decode, and output television content transmitted over the Internet. POR, 64. Petitioner never addressed that in its Petition. POR, 64. See Reply, 36.

Addressing the issue more broadly, Petitioner has the burden of explaining the nature of its proposed combination and how that combination works.

Petitioner's reply does not address any of the Federal Circuit case law requiring the Petitioner to explain how its proposed modified Vasilevsky system works. See POR, 64-65 (citing *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016); *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1368 (Fed. Cir. 2012)). See Reply, 35-39.

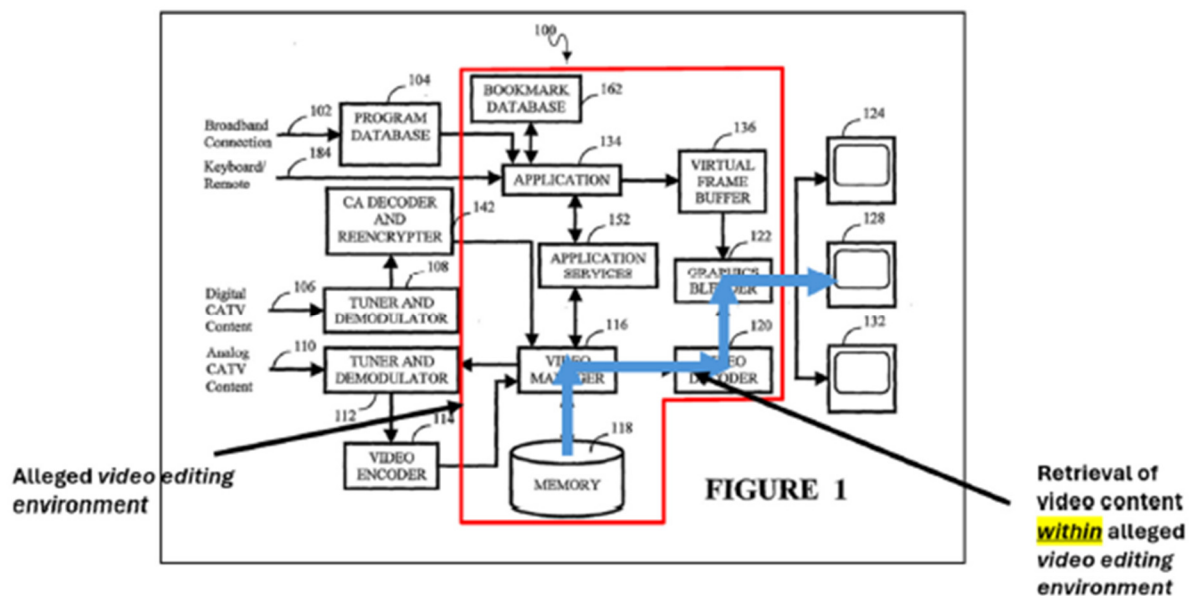
The Reply asserts (at 35) that a POSITA has common sense. Nobody disputes that. But it does not cure the deficiencies in Petitioner's proposed modified system, its failure to explain how it would work, and its failure to explain how its proposed modified Vasilevsky system (not the unmodified Vasilevsky system) would meet the various claim limitations.

Additionally, the Petition failed to even make an assertion, let alone establish, that the proposed modified Vasilevsky system would have a reasonable expectation of success. POR, 66-47 (citing Pet., 76-78). See Mahon Decl., ¶¶ 326-348. Petitioner's attempt to address reasonable expectation of success on reply (at 36-37) is too little, too late. Establishing a reasonable expectation of success is a fundamental requirement of an obviousness theory that must be set forth in the Petition, and its omission cannot be cured on reply.

B. Vasilevsky/Logan Fails to Meet Limitation 13.2

Petitioner fails to establish that the red-boxed *VEE* in Vasilevsky *receives a set of video information **at** the [alleged] video editing environment*. Pet., 68.

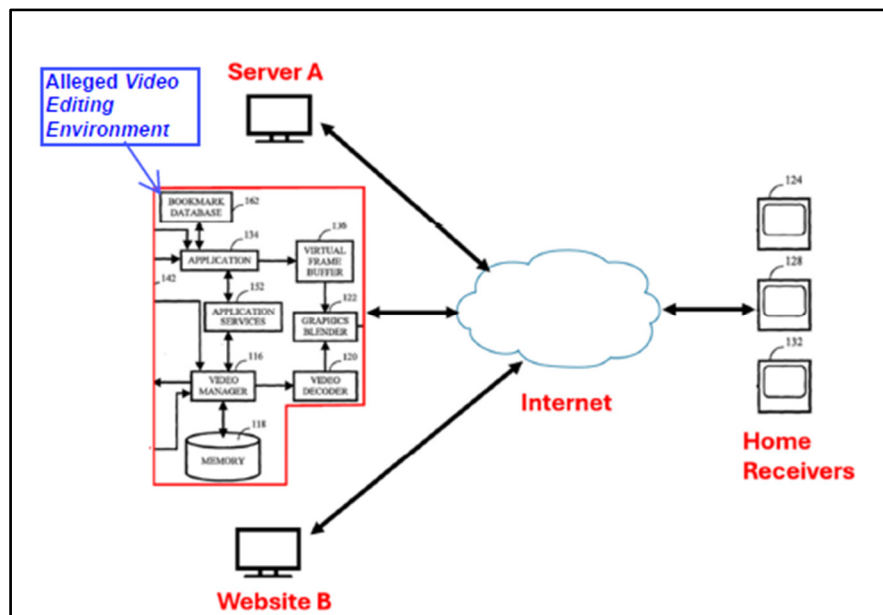
Petitioner’s theory improperly rewrites “at” to “within” and relies on retrieving video already *within* the VEE from other components *within* the alleged *VEE* as depicted below:



POR, 68 (annotated Fig. 1, Vasilevsky). That does not meet the claim limitation.

Petitioner's argument on reply (at 38) that Patent Owner agreed that limitation 13.2 is met is wrong.

Also wrong is Petitioner's back-up argument that video would be received from the analog/digital CATV television sources of Figure 1 of Vasilevsky. POR, 68-69 (citing Pet., 78-79). That argument fails because it is based on the *unmodified* system of Vasilevsky, not Petitioner's proposed modified Vasilevsky system rehosted onto the Internet that has no cable connections to receive CATV content, as illustrated below:



Mahon Decl., ¶ 340 (Ex. 2022). See POR, 68-69 (Petitioner must analyze the references as combined, not individually, citing *In re Keller*, 642 F.2d at 426).

C. Vasilevsky/Logan Fails to Meet Limitation 13.3

Petitioner fails to establish that the red-boxed *VEE* in Vasilevsky *receives a set of cue point information at the [alleged] video editing environment*. As with limitation 13.2, Petitioner never establishes that this limitation is met by the

proposed modified Vasilevsky system rehosted onto the Internet, as opposed to the unmodified Vasilevsky system. Just as the defender of a patent cannot merely attack the references individually, and must instead address the proposed combination presented by the challenger, the challenger of the patent must demonstrate that the limitations are met by the challenger's proposed combination and not by merely pointing to individual references. *In re Keller*, 642 F.2d 413, 426 (C.C.P.A. 1981). *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). The Reply does not address this issue or these cases whatsoever.

Even if that principle is set aside (it must not be), the operations in the unmodified Vasilevsky system that Petitioner points to involve the creation/transmission of a bookmark (cue point information) *within* the alleged *VEE* rather than receiving a bookmark *at* the alleged *VEE* as limitation 13.3 requires. POR, 70-71. Petitioner's argument on reply (at 38) that the Patent Owner agreed that limitation 13.3 is met is incorrect.

D. Vasilevsky/Logan Fails to Meet Limitations 13.4-13.5

Similar to the problem with limitation 13.2, Petitioner fails to establish that the proposed modified Vasilevsky system rehosted onto the Internet *receives a cue point editing command over the network* from a client terminal per limitation 13.4. POR, 73. In the modified system, the end user devices 124-132 would have to be modified to be able to send a *cue point editing* command over the public network

to the *VEE* rehosted onto the Internet, and the application unit 134 in the *VEE* would also have to be modified somehow to receive and act upon such a command received over the Internet. See Vasilevsky, Fig. 1. Petitioner and its expert never make that showing. POR, 72-73. Petitioner's argument on reply (at 39) does not rehabilitate its Petition, and, significantly, it never addresses the root problem that the Petition does not analyze limitations 13.4-13.5 applied to the modified Vasilevsky *VEE* rehosted onto the Internet, as opposed to the individual reference (unmodified Vasilevsky system).

E. Vasilevsky/Logan Fails to Render Claim 15 Unpatentable

For Claim 15, Petitioner points to Figure 6 of Vasilevsky which states that “[a] system user can enter or modify all of the information.” Pet., 87 (citing Vasilevsky, 22:14-15). That cursory statement does not teach or suggest that the end user device 124 sends a signal *over the network*, let alone one that is an *edit mode entry signal* as claimed. POR, 74-75. Additionally, Petitioner's statement that “client 124 enters a cue point edit mode *by selecting an existing bookmark*” (Pet., 86) is an admission that there is no *edit mode entry signal* sent over the network to enter the cue point edit mode. POR, 74.

On reply, the Petitioner presents a new theory that “the client [e.g., end user device 124 in Vasilevsky Figure 1] **must** issue a command to the server **over the network** to enter an edit command.” Reply, 39 (emph. added). This assertion is

deficient in three respects. First, it is an improper new inherency theory that was not presented in the Petition. See Pet., 87. Second, it fails on the merits because the user could modify annotation information using the GUI of Figure 6 by entering a local annotation without sending a signal over the network. *Par Pharm.*, 773 F.3d at 1194-1996. Third, it fails for the same reason the Petitioner's other arguments fail, which is that it does not demonstrate that the limitation is met by the Petitioner's proposed modified Vasilevsky system rehosted onto the Internet (see Ex. 2022), as opposed to the individual unmodified Vasilevsky system. See Section IX.B-D (citing *In re Keller*, 642 F.2d at 426; *In re Merck & Co.*, 800 F.2d at 1097).

F. Vasilevsky/Logan Fails to Render Claim 18 Unpatentable

For Claim 18, Petitioner points to Vasilevsky's claim 5 that "said media sever is adapted to enable a particular bookmark to be edited only by the user purporting to have established the particular bookmark." POR, 75 (citing Pet., 78). That does not teach that *authentication information* is transmitted *over the network*. On reply, Petitioner alleges that WellcomeMat can offer no alternative explanation. Reply, 40. Not so. A POSITA would readily understand that such authentication information could easily be entered directly into the alleged *VEE* instead of transmitting it over the network. *Par Pharm.*, 773 F.3d at 1194-1996.

Petitioner cannot avoid the fact that Vasilevsky's claim 5 does not remotely teach or suggest transmitting authentication information *over the network*.

X. CONCLUSION

For the foregoing reasons, the Challenged Claims should be confirmed as patentable.

Respectfully submitted,

/Stephen T. Schreiner/
Stephen T. Schreiner, Reg. No. 43,097
CARMICHAEL IP, PLLC

Date: May 7, 2025

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Sur-Reply consists of 5,466 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The Sur-Reply complies with the type-volume limitation of 5,600 words as mandated in 37 C.F.R. § 42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

Respectfully submitted,

/Stephen T. Schreiner/

Date: May 7, 2025

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following document was served by electronic service, by agreement between the parties, on the date below:

PATENT OWNER SUR-REPLY

The names and address of the parties being served are as follows:

Frank M. Gasparo
Jonathan M. Sharret
Stephen K. Yam
Venable LLP
151 West 42nd Street, 49th Floor
New York, NY 10036
Email: fmgasparo@venable.com
Email: jsharret@venable.com
Email: syam@venable.com

Respectfully submitted,

/Stephen T. Schreiner/

Date: May 7, 2025